

**REMARKS**

Claims 1-24 are all the claims now pending in the application. Claims 6-24 have been added as new claims.

Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Higuchi (5,704,854) in view of the Examiner's Official Notice. Additionally, claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Higuchi in view of the Examiner's Official Notice and further in view of Sullivan (U.S. Patent No. 5,688,869). Applicant respectfully traverses these rejections for at least the reasons discussed below.

To be an "anticipation" rejection under 35 U.S.C. § 102, the reference must teach every element and limitation of the Applicants' claims. Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Moreover, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the Examiner must show that the prior art references, when combined, teach or suggest all of the claim limitations. See MPEP § 2143. As a result, in order for the Examiner to maintain a rejection under either 35 U.S.C. § 102 or 103, the references must teach all of the limitations of the claims. Applicant respectfully submits that the references cited above by the Examiner fail to teach or suggest all of the claim limitations as set forth in the present invention.

Higuchi fails to teach an intermediate layer that is harder than the cover. Specifically, claim 1 recites an intermediate layer having a Shore D hardness of 53-65 and a cover having a Shore D hardness of 37-50. In other words, the intermediate layer is harder than the cover. Conversely, Higuchi teaches the exact opposite hardness relationship, namely the cover being

harder than the intermediate layer. Specifically, Higuchi teaches that “the intermediate layer is softer than the cover by a hardness difference of 2 to 20, especially 5 to 15” Shore D degrees. Higuchi, col. 3:45-53 (emphasis added). Furthermore, all of the examples of Higuchi disclose an intermediate layer that is softer than the cover by at least 6 Shore D degrees. Clearly, this does not meet the limitations of claim 1 in which the intermediate layer is harder than the cover. Additionally, it would not have been obvious to one skilled in the art to reverse the hardness relationship taught by Higuchi since Higuchi specifically teaches away from such a relationship. In other words, Higuchi specifically teaches that the intermediate layer must be softer than the cover and there is no teachings with Higuchi which suggests that the opposite hardness relationship would meet the objectives of the Higuchi invention.

Accordingly, Applicant submits that since Higuchi fails to teach the claimed relationship, claims 1-3 and 5 are patentable over the Higuchi reference. Therefore, Applicant requests that the rejection of claims 1-3 and 5 be reconsidered and withdrawn.

Since claim 4 depends upon claim 1 and since Sullivan does not cure the deficient teachings of Higuchi with respect to claim 1, Applicant submits that claim 4 is patentable at least by virtue of its dependency from claim 1. Therefore, Applicant respectfully requests that the rejection of claim 4 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

Regarding new independent claim 6 (and its dependent claims 7-10), for at least the reasons discussed above regarding claim 1, Higuchi fails to teach the limitations of claims 6-10. Furthermore, the Shore D hardness of the intermediate layer of Higuchi et al. is 30 to 55, preferably 32 to 54, which is distinguished from the claimed range of 56 to 65 of claim 6.

Regarding new independent claim 11 (and its dependent claims 12-15), the cited references fail to teach a cover having a gage of 0.5 to 1.0 mm. Specifically, Higuchi describes in column 3 that a cover of less than 1.0 mm thick would lower the durability characteristics of solid golf balls. Thus, claims 11-15 are distinguished from Higuchi since Higuchi fails to suggest that cover has a gage of 0.5 to 1.0 mm.

Regarding new independent claim 16 (and its dependent claims 17-20), Higuchi fails to teach an intermediate layer formed essentially of ionomer resins. The intermediate layer of Higuchi must be formed mainly of a thermoplastic polyester elastomer, which is distinguished from the intermediate layer formed of ionomer resins of claims 16-20.

Finally, regarding new independent claim 21 (and its dependent claims 22-24), Higuchi fails to disclose and teach that the cover of the multi-piece solid golf ball is formed of a urethane resin. Higuchi describes in column 4 that the cover is formed of a composition based on an ionomer resin, and does not mention the use of a urethane resin at all. Thus, the Examiner's statement that "Higuchi discloses the urethane composition throughout his invention (Col. 2)" is inaccurate. Furthermore, although the Examiner takes Official Notice that "it is conventional to make a cover our of urethane resin," the Examiner has not provided any explanation or reference which teaches or suggests that the objectives of Higuchi can be met using a cover made of a urethane resin instead of an ionomer resin. Without such evidence, the Examiner cannot establish a *prima facie* case of obviousness.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

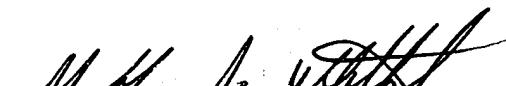
AMENDMENT UNDER 37 C.F.R. § 1.111  
Appln. No.: 09/891,654

Attorney Docket No.: Q65201

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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**APPENDIX**  
**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**The claims are amended as follows:**

1. (Amended) A multi-piece solid golf ball comprising a solid core of at least one layer, an intermediate layer enclosing the solid core, and a cover enclosing the intermediate layer, wherein

    said intermediate layer has a gage  $G_1$  of 0.8 to 2 mm and a Shore D hardness of ~~50~~<sup>53</sup> to 65, said cover has a gage  $G_2$  of 0.5 to 1.3 mm and a Shore D hardness of 37 to ~~53~~<sup>50</sup>, and the gage  $G_1$  of said intermediate layer and the gage  $G_2$  of said cover satisfy  $[G_1/(G_1+G_2)] \times 100 \geq 45\%$ .

2. The multi-piece solid golf ball of claim 1 wherein said intermediate layer has a gage  $G_1$  of 1 to 2 mm.

3. The multi-piece solid golf ball of claim 1 wherein said solid core undergoes a deflection of 3 to 4.5 mm under an applied load of 100 kg.

4. The multi-piece solid golf ball of claim 1 wherein said cover is formed of a cover material having a melt index of at least 3.0 dg/min at 190°C.

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5. The multi-piece solid golf ball of claim 1 wherein said cover is formed of a urethane resin.

**Claims 6-24 are added as new claims.**